

## REMARKS

Claims 1-17 and 19-31 are currently pending in the application. Claims 20-27 have been allowed.

Claims 1-17, 19, 28 and 29 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Each of the independent claims in this group has been amended to address the alleged problem. Withdrawal of the rejection under 35 U.S. C. §112 is thus requested.

Claims 28 and 29 do not stand rejected based upon art. With the rejection under 35 U.S. C. §112 addressed, these claims are believed allowable.

Claims 1-17 and 19 stand rejected under 35 U.S.C. §102 as allegedly anticipated by U. S. Patent Application Publication No. US 2002/0094885 (Finkel).

Reconsideration of the rejection of claims 1-17, 19, 28 and 29 is requested.

Each of independent claims 1, 10 and 19 has been amended to recite that the golf ball maintains the first performance characteristic with the golf ball exposed to water for the duration of a round of golf. This language is supported in the specification on page 10 in lines 18-21. In short, the golf ball is intended to be usable in a conventional manner to play golf in wet conditions. During the round of golf, the ball may be placed into water and recovered and/or continuously exposed to water in a manner typical of playing golf in rainy conditions. Thus, the golf ball is usable in conventional fashion during a round of golf without fear that its performance characteristics will be altered.

However, it is contemplated that the golf ball, upon being continuously exposed to water, will have deteriorated performance characteristics within 180 days that are such that the ball is thereafter not practically usable to play golf with. These limitations are included in each of the rejected independent claims 1, 10 and 19.

The significance of this feature is that, while the ball is usable, even in rainy conditions, during a round of golf, continued exposure of the golf ball to water for a time period less than 180 days causes deterioration to the point that the golf ball is not practically usable to play golf with. Thus, the inventive golf ball is not subject to being recovered from water holes after extended immersion periods for resale.

Finkel, first of all, is not directed to a conventional golf ball but rather to a “short-range practice golf ball” as described in the title and elsewhere throughout the written description therein. The golf ball is intended to “quickly” decompose. Finkel is not concerned with maintaining original performance characteristics for any duration, such as for the duration of a round of golf, as set forth in independent claims 1, 10 and 19.

Finkel specifically describes that “the golf ball material will quickly oxidize, degrade, disintegrate, melt or otherwise decompose to leave products harmless to, or beneficial to, the natural environment” (lines 4-7 of the abstract - our emphasis).

In Finkel’s paragraph [0055], it is stated, “preferably part or all of the golf ball is configured to decompose quickly upon exposure to water, sunlight, or air. For example, in one embodiment of the invention, the golf ball is configured to completely dissolve after being exposed to air, water, or sunlight (or any combination thereof) for a period of time that is three days or less” (lines 4-10 - our emphasis).

This language does not in any way convey that performance characteristics are maintained for any appreciable period of time - complete disappearance of the golf ball is contemplated in “three days or less”.

Finkel unequivocally states that decomposition should occur “quickly”, as a result of which performance characteristics are quickly changed.

In Finkel's paragraph [0078] a construction is described with a water-impermeable membrane 45 that surrounds a shell layer 44. Upon being struck, the water-impermeable membrane shatters to expose the shell layer which "immediately begins to decompose" (our emphasis) .

As stated in Finkel's paragraph [0025] "the golf ball is preferably configured to begin dissolving upon contact with water".

Finkel does not teach or suggest that which is recited in claims 1, 10 and 19. Since Finkel contemplates immediate dissolving of the golf ball, this is inconsistent with the claim language and the intent of the invention. Thus, the structure recited in claims 1, 10 and 19 is not obvious from Finkel.

Claims 2-9 each depends from claim 1 and recites further significant structure with detail to further distinguish over Finkel. Likewise, claims 11-17 depend cognately from claim 10 and recite further significant structure to further distinguish over Finkel.

Reconsideration of the rejection of claims 1-7, 19, 28 and 29 in allowance of the case are requested.

Respectfully submitted,

By \_\_\_\_\_  
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